

REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

As a procedural matter, Applicants respectfully submit that the Examiner has improperly deemed the present Office Action as a Final Office Action. As discussed below, Applicants asserted that the Examiner was basing the previous rejection on facts within the Examiner's personal knowledge. Pursuant to 37 C.F.R. § 1.104(d)2), Applicants requested affidavits in support of this personal knowledge. Section 1.104(d)(2) provides that "such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant or other persons." Therefore, § 1.104(d)(2) provides that affidavits by Applicants in contradiction or explanation of the Examiner's statements must be entered as a matter of right. Because in the present Final Office Action the Examiner has replied to Applicants' assertion with citations to allegedly supporting evidence, Applicants have the right to have their responsive arguments entered as a matter of right. However, arguments are not entered as a matter of right when applications are under final practice. Thus, Applicants request that the status of the present Office Action be changed from final to non-final.

Status of the Claims

Claims 1-26 are pending. Claims 1, 15, 19 and 20 have been amended.
Claims 21-26 have been added. No new matter has been added.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 9-11, 15-16 and 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. RE 30, 666 to Mitchell et al. ("Mitchell") in view of U.S. Patent No. 6,240,391 to Ball et al. ("Ball"). Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 5,926,789 to Barbara et al. ("Barbara"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 5,695,401 to Lowe et al. ("Lowe"). Claims 5, 13, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 6,335,768 to Reinold et al. ("Reinold"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of Reinold and Barbara. Claims 7-8 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of Reinold and U.S. Patent No. 5,850,629 to Holm. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 6,003,090 to Puranik.

The Examiner reiterates his contention from the January 5, 2004 Office Action that "presumably the recordings are produced by recording in any order audio data portions each corresponding to a text section." (Detailed Action, page 2, item 6.) In response to Applicants' request to support his personal knowledge pursuant to 37 C.F.R. §1.104(d)(2), the Examiner cites Mitchell, column 4, lines 20-30 as describing "how the contents of Mitchell's invention may be produced using multiple recording sessions. Clearly, if the contents of the invention can be produced in multiple recording sessions, it would have been obvious to

produce them in any order” (Detailed Action, page 10, item 35.) The passage cited by the Examiner, and its surrounding text, reads as follows:

To accompany, compliment and supplement the aforementioned "System For Arranging and Retrieving Information" there are provided a number of topical video visual recordings such as the one illustrated at 70 in FIG. 4. Recording 70 is shown as housed in a sleeve 72 carried by a jacket 74 having a front cover 76, and a rear cover 78 connected to a spine 80.

While each such recording 70 is herein described as for a single topic corresponding to a topic from the comprehensive illustrated text 10; it should be realized that space requirements for properly covering the topic may dictate the use of multiple recording 70 for a single topic. In the alternative a single recording 70 may cover more than one such topic if the topic content so permits.

Also contemplated by the instant system is a single recording 70, or multiple recordings 70, which encompass the entire illustrated comprehensive text 10, illustrated alphabetical text 40 and illustrated comprehensive index 50.

(Mitchell, column 4, lines 12-34 (emphasis added).) Mitchell's Figure 4 illustrates that recording 70 is a video visual recording in the form of a disc. The passage cited by the Examiner merely contemplates multiple video discs storing recordings, when the "space requirements" for the data being recorded exceeds the capacity of a single visual recording disc. The passage does not disclose nor suggest multiple recording sessions. Therefore, the passage clearly does not disclose nor suggest "recording, in any order, audio data portions each corresponding to a text session" as recited in claim 1. Independent claims 15, 19 and 20 recite similar subject matter, and Applicants submit that the combination of Mitchell and Ball does not disclose nor suggest this feature as recited in independent claims 1 15, 19, and 20.

Applicants submit that Mitchell discloses an audio visual recordation system for encyclopedic texts. (Mitchell, column 1, line 67 through column 2, line 2). Mitchell indexes and cross-references information pictorially and with text descriptions for audio visual presentation of encyclopedic texts. (Mitchell, column 1, lines 10-15). Ball is directed to a voice mail messaging system. (Ball, column 1, line 17). Through the use of a recipient's messaging system, Ball assembles a message that comprises a number of messaging elements, such as message fragments and embedded instructions that define the structure of the message and that reassemble the message fragments into a unified message for presentation to the recipient. (Ball, column 1, line 55 - column 2, line 1).

The present application discloses that synchronization points (or markup tag elements) in the form of synchronization icons (Fig. 4d, items 96a-e) are applied to the source text document. These tags are time stamped to associate audio data portions corresponding to the text sections. (Specification, page 18, lines 12-18.) Activation of a mark button (Fig. 4a, item 86) instructs the computer that an audio portion is to be recorded and synchronized to the displayed text. Once the mark button is activated, the synchronization icon 96a-e, which corresponds to the displayed text section being recorded, can change appearance to reflect that the section is being recorded. (Specification, page 13, lines 12-21.) A subsequent activation of the mark button 86 indicates that the audio portion corresponding to the text section has been completed and a timestamp data file is generated. (Specification, page 14, lines 1-7.)

To further prosecution and expedite allowance, Applicants have amended independent claims 1, 15, 19 and 20. Amended claim 1 now recites "delimiting each of the

segregated text sections with a user interactive synchronization point; providing a user interactive mark button associated with each segregated text section; displaying at least one of the text sections, the delimiting synchronization point, and the associated mark button on a display; associating the synchronization point with a time stamp upon a user's first activation of the mark button; recording, in any order, audio data portions each corresponding to a text section," and "producing a timestamp data file entry upon a user's subsequent activation of the mark button at the completion of the recording step." Amended claim 19 recites similar steps. Apparatus claims 15 and 20 now recite apparatus directed to similar subject matter.

Applicants submit that the combination of Mitchell and Ball neither discloses nor suggests, singly or in combination, the subject matter recited in amended independent claims 1, 15, 19 and 20. Therefore, Applicants submit that claims 1, 15, 19 and 20 are patentable over the combination of Mitchell and Ball. Claims 3, 9-11 and 19 depend from claim 1. Claims 16 and 20 depend from claim 15. Applicants submit that claims 3, 9-11, 16 and 20 are patentable over the combination of Mitchell and Ball for at least the same reasons as their respective base claims. Therefore, Applicants request withdrawal and reconsideration of the rejection.

With respect to the rejection of claim 2, Barbara was cited to show audio files on pages indexed via links in order to aid in their retrieval. Because claim 2 depends from claim 1, claim 2 recites the features of amended claim 1 as if set forth therein. Barbara, however, fails to disclose those features of claim 2 recited in amended claim 1. Thus,

Applicants submit that claim 2 is patentable over the combination of Mitchell, Ball and Barbara. Therefore, Applicants request withdrawal and reconsideration of the rejection.

With respect to the rejection of claim 4, Lowe was cited for its disclosure of the use of a start and an end marker in narration. Because claim 4 depends from claim 1, claim 4 recites the features of amended claim 1 as if set forth therein. Lowe, however, fails to disclose those features of claim 4 recited in amended claim 1. Thus, Applicants submit that claim 4 is patentable over the combination of Mitchell, Ball and Lowe. Therefore, Applicants request withdrawal and reconsideration of the rejection.

Reinold was cited for its disclosure of the encoding of audio into formats such as RealAudio and WAV, and storage on CD-ROMS and DVDs. Holm was cited for its disclosure of a text-to-speech production from selected sections of documents in a display. Reinold and Holm, however, each fail to disclose those features recited in dependent claims 5-8, 13, 14, 17 and 18 that are recited in their respective base claims. Therefore, Applicants submit that claims 5-8, 13, 14, 17 and 18 are patentable over the combination cited by the Examiner. Withdrawal and reconsideration of the rejection is requested.

With respect to the rejection of claim 12, Puranik was cited to show the advantages of using HTML. Because claim 12 depends from claim 1, claim 12 recites the features of amended claim 1 as if set forth therein. Puranik, however, fails to disclose those features of claim 12 recited in amended claim 1. Thus, Applicants submit that claim 12 is patentable over the combination of Mitchell, Ball and Puranik.

Additionally, Applicants submit that there is no motivation in either Mitchell, Ball or Puranik to combine these references. Puranik is directed to the management of computer networks, and more specifically to determining the availability of devices and paths with a computer network to report on the network's availability. (Puranik, column 1, lines 9-13.) A person of ordinary skill in the art of synchronizing text or images to speech would not look to Puranik to achieve the invention of claim 12.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

There is no suggestion in Mitchell, Ball or Puranik to combine these references. Instead, the Examiner has impermissibly relied on the disclosure of the present application “to

reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a 'blueprint' when prior art references require selective combination to render obvious a subsequent invention." (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, citing *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Applicants request withdrawal and reconsideration of the rejection.

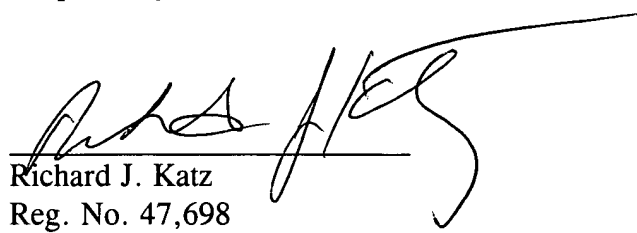
CONCLUSION

Each and every point raised in the Final Office Action dated July 14, 2004 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-26 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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